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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/945,705	02/23/1997	MICHIYA YAMADA	JP6-131165	3016

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EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/945,705

Applicant(s)

YAMADA ET AL.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicants' amendments to page 6, line 27 and to claim 2 in Paper No. 20 dated February 21, 2003 have been entered on record. The pending claims of record are claims 1-5.

The amendment filed February 21, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

The added material which is not supported by the original disclosure is as follows: The amendment to page 6, line 27 is considered as new matter because it broadens the claims which contradicts the more narrower scope of originally filed claims 1-5 and the disclosure at pages 3, 6-7 and 12-15 of the instant specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The limitation set forth in part (b) for the zinc dialkyldithiophosphate (ZnDTP) component is considered as new matter for the "(ii) mixture group" and the "(iv) mixtures thereof that includes (ii)" that was not set forth in the originally filed specification and claims. The claims are further considered as containing new matter for depending on the new matter added and set forth on page 6, line 27 of the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation in claim 2 (b) line 4 that "secondary alkyl group having 1 to 18 carbon atoms" contradicts the meaning that a secondary alkyl group requires the presence of at least three (3) carbon atoms. Clarification is required. In part (b) of claim 2 the (i) component and the (iii) component duplicates one another. One of the component either (i) or (iii) should be cancelled by applicants.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4-5 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-6 and 8 of co-pending Application No. 08/987,404. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are directed to a lubricant composition comprising DTC, ZnDTP and alkylate salicylate and a lubricating oil that encompasses and renders obvious the specific lubricating blend comprising the same oil and additives of the co-pending application. The open-ended language "comprising" of the co-pending application would not exclude the alkylsalicylate component of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 3-5 remain rejected under 35 U.S.C. 102(a) as being clearly anticipated by Inoue et al (Inoue) 5,744,430 for reasons made of record in Paper No. 18 dated June 27, 2002.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 3-5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al (Igarashi) 5,281,347 in view of Papay et al (Papay) 4,178,258, and Umemura et al (Umemura) 4,692,256 and White et al (White) 4,330,420 for reasons made of record in Paper No. 18 dated June 27, 2002.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al (Igarashi) 5,281,347 in view of Papay et al (Papay) 4,178,258, Umemura et al (Umemura) 4,692,256 and White et al (White) 4,330,420 as applied to claims 1 and 3-5 above, and further in view of Le Suer 3,254,025.

Applicants further comprises the addition of a boron containing succinimide component providing 0.005 0.06% by weight boron to the total composition wherein the primary reference is silent to said teachings.

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Le Suer teaches a similar lubricating oil comprising a boron succinimide added to the lubrication composition from about 0.1% to about 10% by weight, column 21, line 73 to column 22 lines 1-2 and 34-36 and column 27, lines 28-31. It is the examiner position that the 0.1% boronated succinimide would reasonable be expected to provide 0.005-0.06% boron to the lubricant composition of Papay when added to the composition in place of the non-boronated succinimide (column 4, line 9) rendering the instant claim composition obvious.

Applicant's arguments filed February 21, 2003 have been fully considered but they are not persuasive.

The amendment to claim 2 with respect to the boron content and the 112 issue is deemed moot. However, applicants' amendment to claim 2 with respect the zinc alkyl phosphate groups have not over the 112 issues for reasons set forth supra.

The obvious-type double patenting rejection over 08/987,404 is maintained as being proper because applicant's instant claims 1-2 and 4-5 are broadly directed to lubricant base oil that renders the co-pending claims obvious.

The examiner maintains that the 102 (a) rejection over Inoue '430 is proper for reasons made of record. Inoue clearly teaches secondary alkyl group for the ZnDTP, note footnote 5 of Table I. The reference discloses 0.02 to 1.5% weight MoDTC, note claim 1, Ca salicylate 0.5 to 1.2 %, note claim 1 and 0.04 to 0.10% ZnDTP, note claim 1 that clearly anticipates the instant claims.

The examiner maintains the position stated on record that under the 103 rejection the secondary reference are properly combined with the primary reference.

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The secondary references are maintained for their teachings set forth on record. The instant claims are not directed to the scope as argued by applicant with respect to point 1 on page 4 of Paper No. 20. The prior art clearly teaches primary and secondary alkyl ZnDTP used in the relative proportions of the instant claims.

With respect to applicant's argument with respect to point 3 on page 4 of Paper No. 20, the claims as written directed to 0-50% by weight the balance calcium reads on the entire proportion being calcium because zero indicates the other component is not required. Thus the relied art teaches the claimed limitation.

With respect to the lubricant being between 3 to 10 TBN, the examiner takes the position that it has been held that when a composition contains the same components in the same relative proportion then it would be reasonable be expected that the composition would have the same physical and chemical properties. The teachings of the primary reference with the teachings of the secondary reference would reasonable be expected to have a TBN of 3 to 10 rendering the instant claims obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday--Friday from 7:30 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.B.Medley/dh
June 23, 2003


MARGARET MEDLEY
PRIMARY EXAMINER